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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/799,124 | 03/15/2004 | Andrew J. Berokoff | 134/156 | 7077 |

27612 7590 06/22/2006

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BLAU, STEPHEN LUTHER

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| ART UNIT | PAPER NUMBER |
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3711

DATE MAILED: 06/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/799,124 | Applicant(s) BEROKOFF, ANDREW J. | |
| | Examiner Stephen L. Blau | Art Unit 3711 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-13 and 27-35 is/are pending in the application.
- 4a) Of the above claim(s) 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 5-8, 10-13, 27-28 and 30-35 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claim 29 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species of figure 3, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 11-12, 27, and 32-33 are rejected under 35 U.S.C. 102(b) as being anticipated by 2003-79776.

2003-79776 discloses a grip in the form of a rail and grip combination with the rail mounted to a grip (Fig. 1, English Solution), a shaft connecting the grip to the head (Fig.

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1), a sliding grip portion sliding on the grip (Fig. 1, English Solution), an iron (Fig. 1), a wood (Fig. 3), a sliding grip portion adapted to slide on an upper grip portion in the form of designating the top part of the rail as part of the upper grip portion (Fig. 1), an upper stop (Ref. No. 3, Fig. 1), and a lower stop in the form of the strap (Ref. No. 2) which would go over the rail and hold the rail to the shaft which would prevent the sliding section (Fig. 2) to pass (Fig. 1).

4. Claims 1, 27, and 34-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Kallassy.

Kallassy discloses a grip (Ref. No. 114, Fig. 11), a sliding grip portion (Ref. No. 100, Col. 6, Lns. 47-65), a lower grip portion (Fig. 11), an upper grip portion (Fig. 11), a slide grip portion adapted to slide on a grip (upper grip portion) (Col. 6, Lns. 47-65), and a sliding grip able to rotate and slide longitudinally in the form of shape of the inner surface of the slidable grip portion being circular (Fig. 8) and it is placed on a standard golf club handle (Col. 6, Lns. 47-65).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 10, 27, and 30-32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suesman in view of Martin.

Suesman discloses a grip (Ref. B,d,f), a sliding grip portion (Ref. C), a lower grip portion (Ref. B), an upper grip portion having an upper stop (Ref. f) and a lower stop (Ref. d) both which limits the sliding grip portion (Fig. 2),

Suesman lacks a slide grip portion adapted to slide on a grip (upper grip portion). Martin discloses a sliding grip portion (12) which slides on an inner sleeve (11) which is attached to a shaft. In view of the patent of Martin it would have been obvious to modify the club of Suesman to have a slide grip portion adapted to slide on a sleeve of a grip (upper grip portion) in order to protect the shaft by not having metallic sleeve sliding and damaging the shaft.

7. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suesman in view of Martin as applied to claims 1-2, 10, 27, 30-31 and 34 above, and further in view of Cheng.

Susesman discloses a sliding grip portion being just less than 50% the length of a grip (Fig. 2).

Susesman lacks a sliding grip portion being approximately four inches in length.

Cheng discloses a grip section having a length of 8-10 inches (Col. 4, Lns. 41-52). In view of the patent of Cheng it would have been obvious to modify the grip of Susesman to have an overall length of 8-10 inches and have a sliding grip portion being

approximately four inches in length in order to utilize a total length of a grip which is used in the market place for golf clubs.

8. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suesman in view of Martin as applied to claims 1-2, 10, 27, 30-31 and 34 above, and further in view of Nesbitt and Cheng.

Suesman lacks a sliding grip portion being approximately one inch in diameter.

Nesbitt discloses a grip having an outer diameter of 1 inch (Col. 6, Lns. 49-54) and a thickness being 9/32 to 1/16 inch (Col. 9, Lns. 1-11). Cheng discloses a cylindrical grip section of a shaft being .81 to 1 inch (Fig. 2, Ref. No. 20, Col. 4, Lns. 41-52). In view of the patents of Nesbitt and Cheng it would have been obvious to modify the club of Suesman to have an outer diameter of a sliding grip portion being approximately one inch in diameter in order to utilize a grip diameter used in the market place for a club.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suesman in view of Martin as applied to claims 1-2, 10, 27, 30-31 and 34 above, and further in view of Young.

Suesman lacks a club being a putter.

Young discloses a club being a putter (Title). In view of the patent of Young it would have been obvious to modify the club of Suesman to be a putter in order to utilize the advantages of the grip of Suesman to a putter club.

10. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suesman in view of Martin as applied to claims 1-2, 10, 27, 30-31 and 34 above, and further in view of Engfer.

Suesman lacks a lower grip portion being a constant diameter.

Engfer discloses a grip being cylindrical along the exterior of the grip (Fig. 4). In view of the patent of Engfer it would have been obvious to modify the grip of Suesman to have a lower grip and upper grip portion being a constant diameter in order to have the same feel along the length of the grip.

Allowable Subject Matter

11. Claims 3-4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. None of the prior art discloses or renders as obvious an upper grip portion having an upper stop and a lower stop, a sliding grip portion is limited by an upper stop and a lower stop to travel of approximately two inches to approximately three inches in addition to the other elements of structure claimed.

Response to Arguments

12. Applicant's arguments with respect to claims 1-8 and 10-13 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Slb/20 June 2006



STEPHEN BLAU
PRIMARY EXAMINER